

Remarks/Arguments

35 U.S.C. § 103

Claims 1, 6-10 and 13-18 were rejected as being unpatentable over Call (U.S. Patent No. 4,083,780). The applicant disagrees for the reasons stated below.

The examiner readily admits that Call fails to teach or suggest a downstream inlet through which additional fluid feed flows into the inner casing. This limitation is recited in independent claims 1 and 17. After admitting that a down-stream inlet is not taught, the examiner, however, attempts to imply the existence of an inlet by equating such to “the feed bypass around the brine seal”. There is no feed bypass around the brine seal. Instead, Call teaches that the brine seal prevents bypass (see claim 6, for example: “The apparatus of claim 5 including means for sealing said convoluted spiral wrap membrane elements within said support tube means to prevent by-passing of said feed fluid around said elements.” and column 4, lines 39-46: “...means for sealing the spiral wrap membrane elements within the support tubes is provided to insure that all feed fluid is directed through the spiral wrap membrane elements within the support tubes without by-passing through the small space between the slightly larger diameter support tubes and the smaller diameter spiral wrap membrane elements.” column 4, lines 39-46).

The examiner continues by stating that the prior art element (assumed by the applicant to be the “by-pass”) performs the identical function in the substantially the same way. The applicant disagrees that the function-way-result test is applicable to finding a claim element by inherency. In the case cited by the examiner (*Kemco Sales, Inc v. Control Papers Co.*, 208 F.3d 1352), the function way-result test was used in the context of proving infringement of a means-plus-function claim. Not only do the present claims lack means-plus-function language, but this is a patentability analysis, not an infringement analysis. “[T]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill...The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”

Inventor: Chancellor, Dennis
Serial No.: 10/019,066
Attny Dkt. No. 100349.0055US1

Art Unit: 1723
Examiner: Krishnan S. Menon

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). Surely, a downstream inlet is not necessarily present in Call and one skilled in the art could not read Call to include a downstream inlet just by the mere recitation of the word "by-pass".

Conclusion

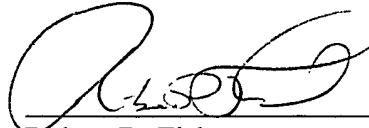
Based on the failure of the references to teach or suggest each and every claim limitation of claims 1 and 17, the obviousness rejections have been traversed. The applicant submits that all claims are now in condition for allowance.

Respectfully submitted,

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Dated: April 6, 2004

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